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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,139	09/22/2003	Rich Sugimae	0EKM-104904	2015

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary

Application No.

10/668,139

Applicant(s)

SUGIMAE.ET AL.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 6-10 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 11 and 14-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/18/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 12-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 20 June 2005.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the chamfer formed on an exterior surface at a bottom end of a body in claim 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is uncertain how to form a chamfer on an exterior surface at a bottom end of the body as stated in claim 6. Only a chamfer on an interior surface is shown (Fig. 7). This is not disclosed in the specification or drawings.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Risher.

Risher discloses a ferrule having a lower portion configured to receive an end of a hosel (Fig. 4), a lower portion including an annular ridge (42) positioned in the axial bore and configured to cooperate with an annual recess (40) defined in an outer surface of a hosel to inhibit longitudinal movement of the ferrule (Fig. 4) and a lower portion having an interior surface about an axial bore configured to cooperate with the end of the hosel to inhibit axial rotation of the ferrule in the form of the ridge (rib) and recess (groove) filled with adhesive material (Col. 2; Lns. 31-34).

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Risher as applied to claims 1-2, 4, and 7 above, and further in view of Johnson.

Risher lacks a chamfer on an exterior surface at a bottom end of the body. Johnson discloses a ferrule having a chamfer on an exterior surface at a bottom end of the body inside the bore (Fig. 9). In view of the patent of Johnson it would have been obvious to modify the ferrule of Risher to have a chamfer on an exterior surface at a

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bottom end of the body inside the bore in order to guide the end of the hosel into the ferrule bore.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Risher as applied to claims 1-2, 4, and 7 above, and further in view of Butler (5,797,806).

Risher discloses a ferrule being an elastomer (Col. 2, Lns. 13-16).

Risher lacks a ferrule formed with a density less than 2 g/cc and a modulus of elasticity no greater than about 3 Gpa.

Butler discloses a ferrule being an elastomer and preferably formed of Delrin or Nylon (Abstract). Butler does not disclose the density or elasticity of the ferrule but clearly one skilled in the art of forming an elastic ferrule which is light weight would have selected suitable properties in which a density less than 2 g/cc and a modulus of elasticity no greater than about 3 Gpa are included. In view of the patent of Butler it would have been obvious to modify the ferrule of Risher to be made of Delrin or Nylon in order to utilize an elastomer material used in the market place for ferrules. It would have been obvious to modify the ferrule of Risher to have a density less than 2 g/cc in order to minimize weight added to a club. It would have been obvious to modify the ferrule of Risher to have and a modulus of elasticity no greater than about 3 Gpa in order to be able to stretch the ferrule over the hosel and place the rib in the groove.

9. Claims 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Risher in view of Official Notice.

The examiner takes Official Notice that it is well known to have a shaft having an upper end adapted to be gripped by a golfer.

See paragraphs above for elements of structure previously rejected by Risher.

Allowable Subject Matter

10. Claims 3, 5, 11 and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claims 3 and 11, none of the prior art discloses or renders as obvious an upper portion including a plurality of protrusions in addition to the other elements of structure claimed. With respect to claim 5, none of the prior art discloses or renders as obvious at least one groove formed on an interior surface of a lower portion configured to be received within a rib on an outer surface of a hosel to inhibit axial rotation. With respect to claim 14, none of the prior art discloses or renders as obvious a longitudinal rib on an interior surface of a ferrule and a corresponding groove on the outer surface of a hosel in addition to the other elements of structure claimed.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406.

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The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 10 July 2005


STEPHEN BLAU
PRIMARY EXAMINER